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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
913,500	06/07/78	Masaru Iwanami, et, al.,	UWP1764

Burgess, Ryan & Wayne
370 Lexington Ave.
New York, N.Y. 10017

EXAMINER	
Rizzo	
ART UNIT	PAPER NUMBER
122	11

DATE MAILED:

MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

JUN 30 1980

☒ This application has been examined.

☒ Responsive to communication filed on 03-04-80

☒ This action is made final. **GROUP 120**

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited, Form PTO-892.

2. ☐ Notice of Informal Patent Drawing, PTO-948.

3. ☐ Notice of Informal Patent Application, Form PTO-152.

4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.

Of the above, claims 8-10 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1, 11 are rejected.

5. ☒ Claims 2-7, 12 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ The formal drawings filed on _____ are acceptable.

8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.

9. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has

☒ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____

filed on _____

10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. ☐ Other

Art Unit 122

1. The claims are 1-12

2. Claims 8-10 are withdrawn from further consideration.

See Paper No. 9.

3. Claims 1 and 11 are again rejected as failing to comply with the requirements of 35 USC 112, 1st & 2nd par. Terms such as "an aryl group:", "an aroyl group:", "functional derivative radical thereof" "a heterocyclic group", are all both too broad and indefinite. In re Wiggins 179 USPQ 421,424.

4. Applicants traverse the rejection. As support for their position applicants cite the Scherberich decision (Ex part Scher^{er}berich et al 20¹ USPQ 397 and Altermatt (Ex parte Altermatt^{183 USPQ 436}). A reading of the Scherberich desision shows that the claims ~~183 USPQ 436~~ involved process claims whereas present Claim 1 and 11 are product claim. The Altermatt case involved a dystuff case. As was stated in the last Office action the problem posed by the aforementioned terms is that they do not possess "fixed" meanings. Attention is again called to the Wiggins and cases cited previously. Moreover, and this cannot be minimized, the claimed compounds have as their utility antibacterial action. As such it cannot be stated that any and all variable would be equally operative, if operative at all. Also, as to the rejected term what is the point of attachment to be? This is obviously critical in an antibiotic. →

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compound. Thus applicants have failed to indicate what they regard as their invention.

An issue has been reached.


This rejection is made FINAL.

Rizzo:cvm

A/C 703

557-3032

5/28/80


NICHOLAS S. RIZZO
EXAMINER
GROUP ART UNIT 122